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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,072	11/15/2001	Kiyoshi Okamura	108915-00003	9487

7590

11/18/2003

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,072

Applicant(s)

OKAMURA ET AL.

Examiner

Katarzyna Wyrozebski Lee

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5-10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

In the amendment filed on 9/22/2003 the applicants amended independent claims to recite limitations of depending claims where the organic medium is a mixture of organic solvent and water. In view of the above amendment, it is examiner's position that the prior art of record is still applicable against present claims therefore; rejections of record are hereby restated.

In the amendment claims 2, 4, 11 and 14 have been cancelled.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3, 5-10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 9-220524 in view of KAWABATA (US 4,442,140).

The discussion of the disclosures of the prior art of JP 9-220524 and KAWABATA from paragraph 6 of the previous office action mailed on 6/18/2003 is incorporated here by reference.

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 9-220524 in view of KAWABATA (US 4,442,140) as applied to claims 1, 3, 5-10, 12 above, and further in view of EP 913 447.

The discussion of the disclosures of the prior art of JP 9-220524, KAWABATA (US 4,442,140 and EP 913 447 from paragraph 7 of the previous office action mailed on 6/18/2003 is incorporated here by reference.

In the amendment filed on 9/22/2003 the applicants argued following:

a) The prior art of KAWABATA clearly teaches away from using organic solvents because of the possibilities of environmental pollution and fire hazard and that moreover good economy is achieved by avoiding waste of resources. JP 9-220524 and KAWABATA cannot be properly combined.

The examiner agrees. The fact that the prior art of KAWABATA does not want to utilize harmful solvents it does not mean that the solvents are not utilized at all. The examples of the prior art of KAWABATA disclose that aqueous composition comprising titanium dioxide is combined with wax emulsion to make the composition. The wax emulsion contains morpholine and morpholine was never removed (col. 6). Basically one can use solvents but the right one. Morpholine is considered a solvent and it is miscible with water, hence the aqueous nature of the composition of KAWABATA.

With respect to the prior art of JP 9-220524, in the office action mailed on 6/18/2003 the examiner discussed the particle size of the titanium dioxide, organic solvent and wax. The *prima facie* obviousness is established as both compositions disclose use of organic solvents, titanium dioxide and wax. Inclusion of water in addition to organic solvent is therefore rendered as obvious. The resulting composition is therefore still expected to form coating.

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b) EP 913 447 was utilized only because it teaches inclusion of a surfactant.

The examiner agrees.

Beginning December 12, 2003 US Patent Office will change its location as a result of which phone numbers will change. New phone number for the examiner of record will be (571) 272-1127.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Katarzyna Wyrozebski
Katarzyna Wyrozebski Lee
Primary Examiner
Art Unit 1714

November 14, 2003